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10/749,820	12/31/2003	Michael D. Kotzin	CS22914RA	9362
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MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			EXAMINER	
			LE, CANH	
			ART UNIT	PAPER NUMBER
			2139	
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			08/05/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/749,820

Applicant(s)

KOTZIN ET AL.

Examiner

CANH LE

Art Unit

2139

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-2, 4-11, and 13-17.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kristine Kincaid/
Supervisory Patent Examiner, Art Unit 2139

Applicant's arguments filed 07/14/2008 have been fully considered but they are not persuasive.

The response to the argument in this remark has been addressed previously in the Final Office action mailed out 05/14/2008. The Examiner hereby emphasizes the prior arts teach the claimed subject matter.

Regarding to claim 1, the Applicant argues that the phrase "subsequent to issuing the plurality of random challenges to the electronic device and receiving from the electronic" is not redundant.

The Examiner respectfully disagrees with the applicant with the following reasons:

Claim 1 recites the limitation as the following:

(a) issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic device;

(b) obtaining one of the challenge response pairs associated with the electronic device subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of responses from the electronic device;

The phrase "subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of responses from the electronic device" is redundant and does not change the scope of the limitation. An electronic device can not obtain one of the challenge response pairs without getting an issuance the plurality of random challenges to the device. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Appropriate correction is required.

With regard to claims 1-2, 4-11, and 13 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 5,668,875 (Brown) in view of US 2003/0233546 (Blom), the Applicant argues that Malinen, Brown, or Blom does not show or suggest obtaining a challenge response pair subsequent to issuing a random challenge and receiving the response.

The Examiner respectfully disagrees,

Malinen teaches obtaining one of the challenge response pairs associated with the electronic device [par. [0083], lines 7-12; par. [0011], lines 1-3; "an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific"];

Malinen does not teach issuing plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Brown teaches a method, wherein issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic [col. 4, line 66 to col.5 line 3; col. 11, lines 14-17; a RAND generator 136 is used for generating the challenges in communication with the subscribe unit 110. Once the responses are received at VLR, the MSI, location, service request and RAND/RESPv pairs are forward to home system and home location register or other authenticating center for the user identity unit].

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Brown because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

The Applicant amended the limitation in claim 1 as the following:

"obtaining one of the challenge response pairs associated with the electronic device subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device". This is inherent that a device can not obtain one of the challenge response pairs without getting an issuance the plurality of random challenges to the device. Malinen teaches the limitation of "obtaining one of the challenge response pairs associated with the electronic device", while Brown teaches the limitation "issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device". Therefore, the combination of Malinen and Brown teach the limitation as said set forth in claim 1. The new limitation added in claim 1 (i.e. "subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device") is inherent and does not change the scope of the limitation of the previous office action rejection filed on 08/22/2007. The same argument applies for claim 8 and 14.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is proper to combine teaching of Malinen and Brown and further in view of Blom because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

With regard to claims 14-17 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 5,668,875 (Brown) in view WO 00/02406 (Ekberg) and further in view of US 2003/0233546 (Blom), the Applicant argues Ekberg also does not show or suggest "obtaining from an electronic device a plurality of challenge response pairs subsequent to issuance of a plurality of random challenges to the electronic device and receiving a plurality of response from electronic device" as recited by independent claim 14.

The Examiner respectfully disagrees, Please see the same argument which Malinen, Brown, and Blom teach the above limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

1992). In this case, it is proper to combine teaching of Malinen, Brown, Ekberg, and further in view of Blom because Blom discloses the limitation which Malinen, Brown and Ekberg do not disclose such as storing the challenge response pairs [abstract, lines 13-17; pg. 14, lines 27-37; pg. 15, lines 1-9] because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

With regard to claims 1-2, 4-11, and 13 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 2005/0113067 (Marcovici) in view of US 2003/0233546 (Blom), the Applicant argues that Marcovici does not or suggest "obtaining one of the challenge response pairs associated with the electronic device subsequently to issuing the plurality of random challenges to the electronic device and receiving the plurality of responses from the electronic device" recited by independent claims 1 and 8, as amended.

The Examiner respectfully disagrees.

Malinen teaches obtaining one of the challenge response pairs associated with the electronic device [par. [0083], lines 7-12; par. [0011], lines 1-3; "an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific";

Malinen does not teach a method, wherein issuing plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Marcovici teaches a method of issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic device [par. [0036], lines 12-16; "The act of authenticating may include transmitting one or more random challenges and receiving one or more responses associated with the random challenges, where the response(s) may be determined based on applying the WKEY to the random challenge(s)"; par. [0041]; lines 1-10; par. 0041; lines 1-2];

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Marcovici because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

The Applicant amended the limitation in claim 1 as the following:

"obtaining one of the challenge response pairs associated with the electronic device subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device". This is inherent that a device can not obtain one of the challenge response pairs without get an issuance the plurality of random challenges to the device. Malinen teaches the limitation of "obtaining one of the challenge response pairs associated with the electronic device", while Marcovici teaches the limitation "issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device". Therefore, the combination of Malinen and Marcovici teach the limitation as said set forth in claim 1. The new limitation added in claim 1 (i.e. "subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device") is inherent and does not change the scope of the limitation of the previous office action rejection filed on 08/22/2007. The same argument applies for claim 8 and 14.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is proper to combine teaching of Malinen and Marcovici and further in view of Blom because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

With regard to claims 14-17 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 2005/0113067 (Marcovici) in view of WO 00/02406 (Ekberg) and further in view of US 2003/0233546 (Blom) on pg. 11, the Applicant argues that Malinen, Marcovici, Ekberg, and Blom do show or suggest "obtaining from a n electronic device a plurality of challenge response pairs subsequent to issuance of a plurality of random challenges to electronic device and receiving a plurality of responses from the electronic device" as recited by the independent claim 14.

The Examiner respectfully disagrees, Please see the same argument which Malinen, Brown, and Blom teach the above limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is proper to combine teaching of Malinen, Marcovici, Blom, and further in view of Ekberg because Ekberg discloses the limitation which Malinen, Marcovici and Blom do not disclose such as storing the challenge response pairs [abstract, lines 13-17; pg. 14, lines 27-37; pg. 15, lines 1-9] because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative should not be construed as indicating Examiner's agreement therewith.